

Simplification of the Electronic Exchange of Priority Documents

Effective immediately, the United States Patent and Trademark Office (USPTO) is simplifying the procedure for the direct electronic priority document exchange with the European Patent Office (EPO) that was implemented in January 2007. See Changes to Implement Priority Document Exchange Between Intellectual Property Offices, 72 FR 1664 (January 16, 2007), 1315 Off. Gaz. Pat. Office 63 (Feb. 13, 2007) (final rule) (hereinafter "Priority Document Exchange Final Rule").

The Priority Document Exchange (PDX) Final Rule sets forth a procedure whereby an applicant may request that the USPTO retrieve a copy of a foreign priority application when the priority application is available from a foreign intellectual property office participating with the USPTO in a priority document exchange agreement (participating foreign intellectual property office) in accordance with 37 CFR 1.55(d). This procedure requires the applicant to file a request (in a separate document) that the USPTO retrieve a copy of the foreign priority application from a participating foreign intellectual property office. See Form PTO/SB/38. If the foreign priority application was originally filed in a participating foreign intellectual property office (currently the EPO is the only such office), the applicant is required to identify the participating office, the foreign priority application number, and the filing date of the foreign priority application. However, if the applicant wishes the USPTO to retrieve a copy of an application that was originally filed at a non-participating office, in accordance with 37 CFR 1.55(d)(2), the applicant must also provide the application number and filing date of the corresponding participating foreign intellectual property office application in which the non-participating office priority document is located.

As a result of discussions with EPO and the Japan Patent Office (JPO), a soon-to-be participating foreign intellectual property office, this procedure will be simplified as follows: if a US application filed under 35 U.S.C. 111(a) claims priority to an earlier foreign application that was filed directly with a participating foreign intellectual property office (e.g., the EPO) and identifies the foreign application in compliance with 37 CFR 1.55(d)(1)(ii), the USPTO will automatically attempt to electronically retrieve a copy of that foreign (e.g., EPO) priority document without the need for the applicant to file a request to retrieve in a separate document (e.g., form PTO/SB/38). In this situation, the requirement under 37 CFR 1.55(d)(1)(i) that the applicant file a request to retrieve, in a separate document, is hereby waived and the requirement for the certified copy of the foreign application will be considered satisfied if the requirements of 37 CFR 1.55(d)(1)(ii) and (iii) are met.

Thus, if an applicant files a US application under 35 U.S.C. 111(a) claiming priority to a prior-filed EPO application that is identified in the oath or declaration under 37 CFR 1.63 or in an application data sheet under 37 CFR 1.76, the USPTO will automatically attempt to electronically retrieve a copy of that EPO application through the PDX. If the copy of the EPO application is then received by the USPTO within the period set forth in 37 CFR 1.55(a) (e.g., prior to the payment of the issue fee), the requirement under 37 CFR 1.55 for a certified copy of the foreign priority application will be considered satisfied.

On the other hand, if an applicant files a US application under 35 U.S.C. 111(a) claiming priority to an application previously filed with a non-participating office (e.g., a French national application filed with the French office) and the applicant desires the USPTO to electronically obtain that priority document from a corresponding EPO application file, the applicant is still required to file a request to retrieve, in a separate document, pursuant to 37 CFR 1.55(d)(1)(i), identifying both the EPO application file number and the file number of the French priority application. Such identification is required because there currently is no cross

reference from the EPO file number to the prior non-participating office application file number (in this example, the prior filed French application).

The USPTO will not automatically attempt to retrieve copies of priority applications in US national stage applications under 35 U.S.C. 371 since the USPTO already, in most cases, receives copies of such priority applications from the International Bureau in accordance with PCT Rule 17.2.

The EPO is currently the only foreign intellectual property office participating in the electronic PDX program. Accordingly, the only foreign priority applications that the USPTO will automatically attempt to retrieve at this time will be EPO priority applications. However, it is expected that this service will be expanded later in 2007 to include electronic exchange of priority documents between the USPTO and the JPO. At that point, the JPO will become the second participating foreign intellectual property office, and then the USPTO will also automatically attempt to retrieve electronic copies of JPO applications to which priority is claimed in US applications filed under 35 U.S.C. 111(a) on or after that date. More detailed procedures concerning electronic priority document exchange between the USPTO and the JPO will be published in due course.

Form PTO/SB/38 entitled "Request to Retrieve Electronic Priority Application(s)" for making a request in accordance with 37 CFR 1.55(d)(1)(i) is available from the USPTO website at <http://www.uspto.gov/web/forms/sb0038.pdf>. Note, however, that the USPTO will not attempt to retrieve an identified priority application until the applicant identifies the indicated priority application in an oath or declaration or an application data sheet in compliance with 37 CFR 1.63(c).

Retrieval may not be effected until several months after the filing of qualifying new US applications or submission of an appropriate request to retrieve (e.g., form PTO/SB/38).

The EPO and USPTO are currently developing an enhancement to the PDX system that will simplify the process for retrieving copies of non-participating office foreign priority documents under 37 CFR 1.55(d)(2). The enhancement will enable the USPTO to retrieve any priority document originally filed in a European Patent Convention (EPC) member state that is contained in the dossier of an EPO patent application without the need to identify the EPO application number specifically. This enhancement is expected to be implemented in mid 2008. Accordingly, it is expected that as of mid 2008 the USPTO will no longer require a request to retrieve in a separate document (e.g., form PTO/SB/38) from the applicant before attempting to electronically retrieve priority documents originally filed in EPC member states.

Applicants are advised that until such time as the USPTO can update the PDX system that is currently in place, for each US application in which the USPTO successfully retrieves a foreign priority document through the PDX system, the filing receipt for that application will include the following text regardless of whether or not the applicant actually filed a request to retrieve (e.g., form PTO/SB/38):

A proper Request to Retrieve Electronic Priority Application(s) has been received by the USPTO.

The USPTO is working to revise the PDX system to provide more accurate language on the filing receipts but this may take several months to accomplish.

Applicants continue to bear the ultimate responsibility for ensuring that the priority document is filed by the time of patent grant as required under 37 CFR 1.55(a). Accordingly, applicants are encouraged to check Private

PAIR as necessary to confirm receipt of appropriate documents. Priority documents retrieved from the EPO will bear the IFW document title of "Priority documents electronically retrieved by USPTO from a participating IP Office."

In similar fashion, if an EPO application claims foreign priority to a US application, the EPO will automatically attempt to retrieve an electronic copy of the US application. However, the USPTO will release copies of US applications-as-filed to the EPO only if the US priority application has received a national security clearance and: (1) the applicant of the US application provided an appropriate written authority to permit access to application by participating offices (e.g., form PTO/SB/39) under 37 CFR 1.14(h) and 35 U.S.C. 122 (if the US application has not yet been published); or (2) the US application has been published or patented. Written authority under 37 CFR 1.14(h) and 35 U.S.C. 122 may be provided by filing a properly signed "Authorization to Permit Access to Application by Participating Offices" (Form PTO/SB/39) in a US application. Form PTO/SB/39 is available from the USPTO website at <http://www.uspto.gov/web/forms/sb0039.pdf>

Applicants are advised that EPO regulations require a copy of a priority document to be filed with the corresponding EPO application no later than 16 months from the priority date. See EPC Rule 38(3). Because applications are ordinarily published by the USPTO at 18 months from filing, most US applications that are the basis for a foreign priority claim in an EPO application will be unpublished at the time the applicant is required to provide a copy of the US application to the EPO. This means that in most cases it will be necessary to provide the USPTO with appropriate written authorization (under 35 U.S.C. 122 and 37 CFR 1.14(h)) for the EPO to access the US application and obtain a copy, e.g., by submitting a properly signed Form PTO/SB/39. To date, however, the USPTO has received very few such written authorizations. As a result, the USPTO is unable to fulfill the vast majority of requests for US priority documents received by the USPTO from the EPO. Applicants are strongly encouraged to file written authority in accordance with 37 CFR 1.14(h) and 35 U.S.C. 122 for applications in which there is any chance that they will file a subsequent counterpart EPO or JPO application so that those participating foreign intellectual property offices may timely and successfully retrieve the US priority document at no charge to the applicant.

There continues to be no fee for this service.

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